

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:

Michal AMIT et al

Serial No.: 08/635,820

Filed: October 12, 2001

For: CLONAL HUMAN EMBRYONIC ...

Attorney  
Docket: 01/22631

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

PETITION UNDER 37 CFR 1.47(a)

Sir:

This is a Petition pursuant to 37 CFR 1.47(a), wherein a joint inventor has refused to join in an application, for which a fee of \$ 130.00 is due. Please charge my Deposit Account 50-1407 for this fee, as well as any additional fees due. A duplicate of this Petition is included for this purpose.

The above-identified patent application, as filed, included three inventors, Michal Amit, James A. Thomson and Joseph Itsikovitz. Joseph Itsikovitz was erroneously included as an inventor in said application and, contemporaneously with the filing of this petition, a petition under 37 CFR 1.48(a) to delete an inventor, is being filed. The co-inventor James A. Thomson has refused to join in the application and a Declaration containing factual proof of such refusal is attached hereto.

The last known address of the non-signing inventor is:

Prof. James Thompson  
1807 Regent Street  
Madison, Wisconsin 53705

RECEIVED  
JUN 17 2002  
OFFICE OF PETITIONS

It is respectfully requested that prosecution of this application proceed pursuant to 37  
C.F.R. 1.47(a).

Respectfully submitted,



Sol Sheinbein  
Attorney for Applicant  
Reg. No. 25,457

May 6, 2002  
Ramat Gan, Israel

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SUPPORTING DECLARATION TO ACCEPT THE FILING WITH A MISSING  
SIGNATURE OF INVENTOR UNDER 37 CFR 1.47(A)

I, Sol Sheinbein of 1 Oppenheimer Street, Tel Aviv, Israel, declare as follows:

I am the attorney of record of the above-identified patent application.

The non-signing inventor, James A. Thompson, is an employee, or under another type of contractual obligation, to the Wisconsin Alumni Research Foundation (WARF) and it is WARF that directs Prof. Thompson's research activities, including that of participating in the protection of intellectual property rights.

Consequently, there has been numerous correspondence between representatives of WARF acting on behalf of Prof. Thompson and the representatives of the remaining inventors as to the signing of the Oath and Declaration, all resulting in the representative of WARF refusing to have Dr. Thompson sign the requisite documents.

On April 24, 2002 I personally caused a copy of the application, Oath and Declaration fully filled out for Prof. Thompson's signature to be sent to WARF by Israeli Express Mail. A copy of the Express Mail receipt (which is written in both Hebrew and English) as well as a copy of the envelope is attached hereto. In addition thereto, I personally caused a copy of the application, Oath and Declaration fully filled out for Prof. Thompson's signature to be sent to WARF by FedEX and attached hereto is a copy of the

proof of delivery received from FedEx that the same had been delivered on April 25, 2002.

Additionally, on April 25, 2002 I personally caused a copy of the application, Oath and Declaration fully filled out for Prof. Thompson's signature to be sent to directly to him at his home address by Israeli Express Mail. A copy of the Express Mail receipt (which is written in both Hebrew and English) as well as a copy of the envelope is attached hereto. In addition thereto, I personally caused a copy of the application, Oath and Declaration fully filled out for Prof. Thompson's signature to be sent to him by FedEx and attached hereto is a copy of the proof of delivery received from FedEx that the same had been delivered on April 29, 2002.

After the delivery of the documents mentioned above to both WARF and Prof. Thompson, on May 3, 2001 I received an e-mail from Paulanne Cheif, a representative of WARF, stating that Prof. Thompson will not sign the necessary documents. A copy of said e-mail is attached. Dozens of personal attempts of mine to contact Prof. Thompson at his home telephone number and his work number were unsuccessful.

I hereby further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application of any patent issuing thereon.

Respectfully submitted this 13 date of May, 2002



Sol Sheinbein  
Registration No. 25,457

**Sol Sheinbein**

**From:** Chelf, Paulanne [pchelf@warf.ws]  
**Sent:** 03 May, 2002 11:55 PM  
**To:** Sol Sheinbein  
**Subject:** RE: Our Ref: 01/22631 Technion patent application 09/975,011



heinbein letter.doc

Dear Mr. Sheinbein,

Please see attached letter.

Best Regards,

Paulanne Chelf  
WARF

-----Original Message-----

**From:** Sol Sheinbein [mailto:sol@ipatent.co.il]  
**Sent:** Friday, May 03, 2002 10:50 AM  
**To:** Chelf, Paulanne  
**Cc:** gal ehrlich  
**Subject:** Our Ref: 01/22631 Technion patent application 09/975,011

Dear Paulette,

I would appreciate it very much if you could advise me by return e-mail today as to whether you have faxed the executed Declaration of inventor James Thomson back to our office yet? I have not received it. If you have already faxed it, I would appreciate it if you refaxed it to me again. If you haven't faxed it yet, could you advise when we should receive it? The matter is becoming extremely urgent. Thank you.

In your return e-mail, we would appreciate it if you could also include your direct telephone number.

Thanking you in advance for attending to these matters in a timely manner.

Sol Sheinbein  
G. E. Ehrlich (1995) Ltd.  
Gibor-Sport Bldg., 17th Floor,  
28 Bezalel Street, 52521 Ramat-Gan, ISRAEL  
Tel: 972-3-6127676 Fax: 972-3-6127575  
e-mail: sol@ipatent.co.il

May 3, 2001

Mr. Sol Sheinbein  
Gibor-Sport Bldg, 17<sup>th</sup> floor  
18 Bazalel St., 52521 Ramat-Gan, ISRAEL

Dear Mr. Sheinbein,

In addition to my previous email to you regarding my opinion as to the patentability of your reference 1/22631, WARF has also sought the opinion of outside counsel regarding the patentability of this application in light of WARF's published PCT filing. This opinion coincides with my own; that is, WARF's PCT filing is prior art to your filing, and 1/22631 does not contain patentable subject matter in light of this prior art. Given that, it is not in either WARF's or Professor Thomson's interest to participate in this filing.

Best Regards,

Paulanne Chclf  
Intellectual Property Manager  
WARF